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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,797	03/05/2002	Raymond John Herbert	5126	2997

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EXAMINER

CHARLES, DEBRA F

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/087,797	HERBERT, RAYMOND JOHN
	Examiner	Art Unit
	Debra F. Charles	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 April 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Amendment

1. Claim 1 has been amended.

Response to Arguments

2. In response to applicant's argument that Amirpanahi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Amirpanahi solves the problem of determining if there are unused parking fees(Abstract) and then refunds this fee. This solves the same problem the applicant highlights in his application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2,3,7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitchenik (U. S. PAT. 4796193 A), Amirpanahi (U.S. PAT. 5648906 A), and Cordery et al. (U.S. PAT. 5768132 A).

Re claim 1: Pitchenik disclose a method of mail preparation including the steps of: processing a first mail item comprising a mail item in a series of mail items(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20);

effecting an accounting operation in respect of a first postage charge for said first mail item(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20);

generating a first postage indicium to provide evidence that said accounting operation has been effected in respect of said first postage charge(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20);

processing a second mail item comprising a mail item subsequent to said first mail item in said series of mail items(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20);

generating a second postage indicium to provide evidence that said accounting operation has been effected in respect of said second postage charge(Col. 3,

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Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20). And if the first postage indicium is not suitable for use in relation to said second mail item, effecting an accounting operation in respect of a second postage charge for said second mail item(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20).

Pitchenik does not explicitly disclose(s) determining if said first postage remains unused because processing of said first mail item has not been completed; and, if said first postage is unused: determining if said first postage indicium is suitable for use in relation to said second mail item. And if said first postage is unused determining if said first postage indicium is suitable for use in relation to said second mail item; if the first postage indicium is suitable for use in relation to said second mail item, generating a substitute postage indicium to provide evidence in relation to said second mail item that said accounting operation has been effected in respect of said first postage charge.

However, in Col. 2, Lines 50-60, Col. 12, Lines 30-67, Col. 13, Lines 1-5 thereof, Amirpanahi disclose(s) the motion detector determines start and completion of parking of a vehicle in vicinity of the networked computerized parking meter and refunds any unused, remaining parking fee from any parking charge card back to itself and any unused parking fees can be recrated to the parking charge card upon request or upon removal of parked vehicle. This parallels reusing postage from mailings that have not been mailed. And Col. 2, Lines 29-40, Col. 5, Lines 55-67, Col. 6, Lines 15-40, Col. 7, Lines 25-45, thereof Cordery et al. disclose if a previously generated digital token associated with a previous mail collation which was not completed is suitable for use on said mail collation process and the previously generated digital token is utilized for the mail collation in process if the previously generated digital token is suitable for use in said mail collation in process. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenik by adopting the teachings of Amirpanahi and Cordery et al. The motivation to combine these references is to ensure consistent postal accounting operations that uses unused credit and to get the benefit of using a substitute postage indicium.

Re claim 10: Pitchenick discloses a mail preparation apparatus including:

accounting means operable to effect an accounting operation in respect of a first postage charge for a first mail item of a series of mail items and to generate a first postage indicium to provide evidence that said accounting operation has been effected in respect of said first postage charge(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20); said accounting means being operative in processing a second mail item comprising a mail item subsequent to said first mail item in said series of mail items to determine(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20).

Pitchenik fails to disclose if said postage charge remains unused because processing of said first mail item has not been completed. Pitchenik fail to disclose if said first postage is unused to determine if said first postage indicium

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is suitable for use in relation to said second mail item; and if the first postage indicium is suitable for use in relation to said second mail item, to generate a substitute postage indicium to provide evidence in relation to said second mail item that said accounting operation has been effected in respect of said first postage charge and if the first postage indicium is not suitable for use in relation to said second mail item, to effect an accounting operation in respect of a second postage charge for said second mail item and to generate a second postage indicium to provide evidence that said accounting operation has been effected in respect of said second postage charge.

However, in Col. 2, Lines 50-60, Col. 12, Lines 30-67, Col. 13, Lines 1-5 thereof, Amirpanahi disclose(s) the motion detector determines start and completion of parking of a vehicle in vicinity of the networked computerized parking meter and refunds any unused, remaining parking fee from any parking charge card back to itself and any unused parking fees can be recrated to the parking charge card upon request or upon removal of parked vehicle. This parallels reusing postage from mailings that have not been mailed. And in Col. 2, Lines 29-40, Col. 5, Lines 55-67, Col. 6, Lines 15-40, Col. 7, Lines 25-45 thereof, Cordery et al. disclose if a previously generated digital token associated with a previous mail collation which was not completed is suitable for use on said mail collation process and the previously generated digital token is utilized for the mail collation in process if the previously generated digital token is suitable for use in said mail collation in process. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenik by adopting the teachings of Amirpanahi and Cordery et al. The motivation to combine these references is to get the benefit of using a substitute postage indicium and to ensure consistent postal accounting operations that uses unused credit.

Re claims 2 and 3: Pitchenik disclose the accounting operation for the first postage charge relates to the second mail item(Col. 3, Lines 25-67, Col. 4, Lines 1-67, Col. 5, Lines 1-20). Pitchenick does not explicitly disclose(s) the substitute postage indicium is generated as a modification of the first postage indicium and wherein generation of the substitute postage indicium includes providing an indicator in the first postage indicium indicative.

However, in Col. 2, Lines 29-40, Col. 5, Lines 55-67, Col. 6, Lines 15-40, Col. 7, Lines 25-45 and Col. 2, Lines 29-40, Col. 5, Lines 55-67, Col. 6, Lines 15-40, Col. 7, Lines 25-45 thereof, Cordery et al. disclose(s) for a mailpiece that becomes non-mailable during processing, however, the digital token may be reused in an alternate completely different mailpiece out of sequence in the mail generation process. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenik by adopting the teachings of Cordery et al. The motivation to combine these references is to get the benefit of providing an indicator in the postage indicium to distinguish the substitute postage from the initial postage indicium.

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Re claim 7: Pitchenick does not explicitly disclose(s) wherein generation of the first postage indicium is based at least in part on recipient address and wherein the step of determining if the first postage indicium is suitable for use in relation to the second mail item includes the step of determining if a recipient address of the second mail item is the same as a recipient address of the first mail item.

However, in Col. 2, Lines 29-40, Col. 5, Lines 55-67, Col. 6, Lines 15-40, Col. 7, Lines 25-45 thereof, Cordery et al. disclose(s) the secure accounting device does not store prepaid carrier value for use in printing evidence of payment for carrier services. His invention involves the use of digital tokens initially intended for a mailpiece that has been spoiled or not generated for any reason, is equally usable in various other generated is equally usable in various other systems where like electronic postage meters, funds are in a secure accounting device. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenick by adopting the teachings of Cordery et al. The motivation to combine these references is to get the benefit of reusing the postage indicium on a postal item with a different address.

5. Claims 4,5,6,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitchenick, Amirpanahi and Cordery et al. as applied to claims 1 and 3 above, and further in view of Pintsov et al. (U.S. PAT. 6385504 B1).

Re claim 4: Pitchenick, Amirpanahi and Cordery et al. do not explicitly disclose(s) the postage indicium includes a cryptographic token and the cryptographic token is based in part upon the indicator.

However, in Col. 2, Lines 6-67, Col. 13, Lines 1-16 thereof, Pintsov et al. disclose(s) a digital token that is encrypted and unique serial numbers as indicators, and a mailpiece flag. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenick, Amirpanahi and Cordery et al. by adopting the teachings of Pintsov et al. The motivation to combine these references is to get the benefit of providing a cryptographic token based on the indicator or flag.

Re claim 5: Pitchenick, Amirpanahi and Cordery et al. does not explicitly disclose(s) the first postage indicium is generated to include a flag in a first state and wherein the substitute indicium is generated with said flag in a second state different from said first state. However, in Col. 2, Lines 6-67, Col. 13, Lines 1-16 thereof, Pintsov et al. disclose(s) a digital token that is encrypted and unique serial numbers as indicators, and a mailpiece flag. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenick, Amirpanahi and Cordery et al. by adopting the teachings of Pintsov et al. The motivation to combine these references is to get the benefit of providing a cryptographic token based on the indicator or flag.

Re claim 6: Pitchenick, Amirpanahi and Cordery et al. does not explicitly disclose(s) fails to disclose wherein the postage indicium includes a

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cryptographic token and the cryptographic token is based in part upon the state of the flag.

However, in Col. 2, Lines 6-67, Col. 13, Lines 1-16 thereof, Pintsov et al. disclose(s) a digital token that is encrypted and unique serial numbers as indicators, and a mailpiece flag. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenick, Amirpanahi and Cordery et al. by adopting the teachings of Pintsov et al. The motivation to combine these references is to get the benefit of providing a cryptographic token based on the indicator or flag.

Re claim 8: Pitchenick, Amirpanahi and Cordery et al. does not explicitly disclose(s) the steps of storing the first indicium and a marker relating to the stored first indicium and the further step of setting said marker if the processing of the first mail item is not completed.

disclose including the steps of storing the first indicium and a marker relating to the stored first indicium and the further step of setting said marker if the processing of the first mail item is not completed.

However, in Col. 2, Lines 6-67, Col. 13, Lines 1-16 thereof, Pintsov et al. disclose(s) a digital token that is encrypted and unique serial numbers as indicators, and a mailpiece flag. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenick, Amirpanahi and Cordery et al. by adopting the teachings of Pintsov et al. The motivation to combine these references is to get the benefit of providing a cryptographic token based on the indicator or flag.

Re claim 9: Pitchenick, Amirpanahi and Cordery et al. does not explicitly disclose(s) the step of resetting the marker relating to the stored first indicium if the first indicium is determined to be suitable for use in relation to the second mail item.

However, in Col. 2, Lines 6-67, Col. 13, Lines 1-16 thereof, Pintsov et al. disclose(s) a digital token that is encrypted and unique serial numbers as indicators, and a mailpiece flag. Thus, it would have been within the level of ordinary skill in the art to modify the method of Pitchenick, Amirpanahi and Cordery et al. by adopting the teachings of Pintsov et al. The motivation to combine these references is to get the benefit of providing a cryptographic token based on the indicator or flag.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Debra F. Charles

Examiner

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dfc

July 14, 2003


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600